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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/522,055	03/09/00	CHENG	Y 044574-5064

009629  
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HM22/0823

EXAMINER

FATTEN, P

ART UNIT	PAPER NUMBER
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1651

DATE MAILED:

08/23/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/522,055

Applicant(s)  
Cheng et al.

Examiner  
Patricia Patten

Group Art Unit  
1651



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-24 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1651

## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4 and 11-12, drawn to a composition comprising material from Scutellaria, Glycyrrhiza, Ziziphus and Paeonia with a chemotherapeutic compound and a method for treating a disease with such a composition, classified in class 424, subclass 195.1 for example.
- II. Claims 5-10, drawn to a method for increasing the therapeutic index of cancer therapeutic compounds by administration of material from Scutellaria, Glycyrrhiza, Ziziphus and Paeonia, classified in class 514, subclass 908 for example.
- III. Claims 13-16 and 23-24, drawn to a method for treating a disease in a mammal or improving the quality of life of an individual undergoing chemotherapy, with a composition comprising material from Scutellaria, Glycyrrhiza, Ziziphus and Paeonia, classified in class 514, subclass 783 for example.

Art Unit: 1651

IV. Claims 17-22, drawn to a method of modulating hematopoietic activity for the treatment of a disease by administering material from *Scutellaria*, *Glycyrrhiza*, *Ziziphus* and *Paeonia*, classified in class 424, subclass 195.1 for example.

Inventions I - IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention of Group I includes a chemotherapeutic agent which is not found in the inventions of Groups II-IV. Hence, the methods of Groups II-IV are drawn to methods using a different composition other than the one claimed in Group I. The methods practiced therefore, may have a different effect than if the method were practiced with the invention of Group I.

The methods of Groups I-IV are directed to different inventions which are not connected in design, operation, and/or effect. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

In addition, the inventions of Groups I-IV acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one

Art Unit: 1651

group would not necessarily anticipate or even make obvious another group. Hence, the restriction requirement is proper.

A telephone call was made to Mr. Erich E. Veitenheimer on 08/02/2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Application/Control Number: 09/522,055

Page 5

Art Unit: 1651

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



**Christopher Tate**  
**Patent Examiner**